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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/786,680   | 02/25/2004  | Mark Gershburg       | 048797/277742       | 3002             |
| 1109 7590 02/23/2009<br>ANDERSON, KILL & OLICK, P.C.<br>1251 AVENUE OF THE AMERICAS<br>NEW YORK, NY 10020-1182 |             |                      |                     |                  |
| EXAMINER<br>HAIDER, FAWAAD   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 3627   |             |                      |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/786,680

**Applicant(s)**

GERSHBURG ET AL.

**Examiner**

FAWAAD HAIDER

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/26/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28, 35-62 and 69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28, 35-62 and 69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of claims 1-28, 35-62, and 69 in the reply filed on 11/26/08 is acknowledged.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-28 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

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Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-12, 14-15, 18-28, 35-46, 48-49, 52-62, and 69 are rejected under 35 U.S.C. 102(b) as being unpatentable over Aggarwal (6,239,867).

Re Claims 1, 35, 69: Aggarwal discloses comprising the steps of: capturing a first image of a gem item; capturing a second image of said gem item; storing said first image as part of a report for said gem item; and storing said second image as part of said report for said gem item (see Abstract, Summary, ).

Re Claims 2, 36: Aggarwal discloses wherein said first image is captured from a first perspective and wherein said second image is captured from a second perspective (see col.10, lines 57-59).

Re Claims 3, 37: Aggarwal discloses wherein said first image is captured at a first magnification level and wherein said second image is captured at a second magnification level (see col.13, lines 61-65).

Re Claims 4, 38: Aggarwal discloses wherein said first image and said second image are part of a plurality of images that form a 360-degree view of said gem item (see col.13, line 1).

Re Claims 5, 39: Aggarwal discloses further comprising the step of: displaying a three dimensional image of said gem item wherein said three dimensional image is formed from data stored in said report (see Figures 7-9).

Re Claims 6, 40: Aggarwal discloses further comprising the steps of: selecting a perspective by a user; and displaying said first image (see Figures 2 and 7).

Re Claims 7, 41: Aggarwal discloses wherein said first image is from said perspective (see Figures 2 and 7).

Re Claims 8, 42: Aggarwal discloses wherein said first image is a best fit for said perspective in a plurality of images of said gem item that are stored as part of said report (see Figures 2 and 7).

Re Claims 9, 43: Aggarwal discloses further comprising the steps of: selecting a magnification level by a user; and displaying said first image (see col.13, lines 61-65).

Re Claims 10, 44: Aggarwal discloses wherein said first image is at said magnification level (see col.13, lines 61-65).

Re Claims 11, 45: Aggarwal discloses wherein said first image is a best fit for said magnification level in a plurality of images of said gem item that are stored as part of said report (see col.13, lines 61-65).

Re Claims 12, 46: Aggarwal discloses further comprising the step of: displaying a plurality of images stored as part of said report in a pre-determined order (see Figure 7).

Re Claims 14, 48: Aggarwal discloses further comprising the steps of: displaying said first image to an interested party (see col.2, line 45).

Re Claims 15, 49: Aggarwal discloses wherein said interested party is a potential buyer (see col.2, line 45).

Re Claims 18, 52: Aggarwal discloses wherein said student is learning to appraise a type of gem item (see col.2, lines 22-29).

Re Claims 19, 53: Aggarwal discloses further comprising the steps of: capturing a third image of a second gem item; comparing said third image to said first image; and determining whether said second gem item is said gem item (see col.1, lines 46-47).

Re Claims 20, 54: Aggarwal discloses further comprising the steps of: transmitting said first image from a first location to a second location (see col.1, lines 51-54).

Re Claims 21, 55: Aggarwal discloses further comprising the steps of: packaging a printed version of said report together with said report (see col.3, lines 12-15).

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Re Claims 22, 56: Aggarwal discloses further comprising the step of: displaying a photorealistic image of said gem item wherein said photorealistic image is formed from data stored in said report (see Figure 10c).

Re Claims 23-27, 57-61: Aggarwal discloses wherein said step of storing said first image comprises the step of: storing said first image as part of a report for said gem item electronically, holographically, via ionic implant, genetically, or chemically (see Figure 10c).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13, 16-17, 47, and 50-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal (6,239,867) in view of Lapa et al (6,786,733).

Aggarwal fails to disclose the following limitations:

Re Claims 13, 47: Lapa discloses further comprising the steps of: associating a hyperlink to a second data item with a first data item; and storing said first data item and said hyperlink as part of said report (see Figure 5).

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Re Claims 16, 50: Lapa discloses wherein said interested party is a student (see Abstract).

Re Claims 17, 51: Lapa discloses wherein said student is learning to cut a type of gem item (see Abstract).

Re Claims 28, 62: discloses further comprising the step of: encrypting a data item of said report (see col.13, lines 47-48).

From the teaching of Lapa, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Aggarwal's invention with Lapa's disclosure of a hyperlink and a student in order to "measure the one or more optical properties of a particular gemstone provided to the apparatus (see Lapa Abstract)."

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kobayashi (5,430,538) discloses an apparatus to assist in the qualitative evaluation of faceted gems. Valente et al (5,615,005) discloses a gemstone evaluation system. Yoshizawa (5,899,503) discloses a gem certificate, gem grading report, guarantee, and method of guaranteeing jewelry. Shannon Sr. (5,966, 673) discloses a system and method for computerized evaluation of gemstones. Kaplan et al (6,211,484) discloses a laser making system and certificate for a gemstone. Malnekoff (6,304,853) discloses an automated gemstone evaluation system.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fawaad Haider whose telephone number is 571-272-7178. The examiner can normally be reached on Monday-Friday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fawaad Haider/  
Examiner  
Art Unit 3627

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627

